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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,840	06/14/2001	C. Enrique Ortiz	AGEA1130-1	2846
7590	11/22/2004		EXAMINER	
Mr. Ben Smith Director of Operations Avalon Digital Marketing Systems, Inc. 5255 North Edgewood Drive, Suite 250 Provo, UT 84604				BASHORE, WILLIAM L
		ART UNIT	PAPER NUMBER	2176
DATE MAILED: 11/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/681,840	ORTIZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William L. Bashore	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 8/5/2002.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-22 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892) <sup>6</sup>  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 8/5/02.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications: original application filed 6/14/2001 with provisional filing date of 4/6/2001. IDS filed 8/5/2002.
2. Regarding IDS filed 8/5/2002, reference C1 cannot be considered because an International Search Report cannot be cited as prior art.
3. Claims 1-22 are pending. Claims 1, 9, 16 are independent claims.

***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Mobile Presentation System Utilizing Markup Language Transformation.
5. Claims 1-22 are objected to because of the following informalities: Although claims 1-22 are numbered with Arabic numbers, the left margins include brackets (i.e. [c1], etc.) which are unacceptable in the claims, as per MPEP 8<sup>th</sup> Ed. 608.01 – section Paper Requirements, subsection (b)(6). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

**In regard to independent claims 1, 9, 16, Applicant's claiming of “*business logic*” is not sufficiently enabled by the specification. Although said phrase is repeated throughout the specification, said specification does not shed light as to the meaning of said phrase, how said phrase is defined, as well as how a “*business logic*” is to be applied to the invention.**

**In regard to dependent claims 2-8, 10-15, 17-22, claims 2-8, 10-15, 17-22 are rejected for fully incorporating the deficiencies of their respective base claims.**

8. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**In regard to independent claims 1, 9, 16, the phrase “*business logic*” is vague and indefinite. It is unclear to the examiner how this phrase is defined and used within the context of the claimed invention.**

**In regard to dependent claims 2-8, 10-15, 17-22, claims 2-8, 10-15, 17-22 are rejected for fully incorporating the deficiencies of their respective base claims.**

*Examiner's Comment*

10. The following rejections are based upon a possible interpretation of “*business logic*” as relating to or associated with some form of business (i.e. retail, etc.).

*Claim Rejections - 35 USC § 103*

11. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spyglass Prism Concepts And Applications (hereinafter Spyglass), 1997 Spyglass Corporation, pages 1-8, in view of Carlino, Kenneth F. et al. (hereinafter Carlino), PCT International Publication Number WO 00/39666, publication date: July 6, 2000, International Application Number: PCT/US99/31048.**

In regard to independent claim 1, Spyglass teaches a method of generation (transformation) of an initial Web page into a final form which is customized for specific registered devices. The initial request for a Web page is initiated by a user on a device (Spyglass page 2 – top half of page, especially items 1-4, also Figure; compare with claim 1 “*A method of generating an information for a first user comprising:*” and “*receiving a first request for the information from the first user, wherein the first request came from a first device of the first user*”).

Spyglass teaches subsequent to said device connecting to a Spyglass server, said server accessing the URL requested by the user (the accessed Web page containing displayed presentation information along with information within its HTML coding) open for analysis and eventual customization (Spyglass page 2 items 3, 4). Spyglass teaches, as an example, a “Chicago Traffic Report” showing a sponsorship banner in the lower right portion, said report and banner indicative of a business logic (i.e. the sponsors support the Webmaster’s business of supplying said page to the public, etc.) (Spyglass page 7) (compare with claim 1 “*accessing a presentation information and a business logic corresponding to the first request;*”).

Spyglass teaches a device identifying itself to the Spyglass server, said server accessing a device database for determining device attributes (Spyglass page 2 item 2; compare with claim 1 “*determining an attribute of the first device;*”).

Spyglass teaches a content converter for converting Web pages accordingly. The conversion comprises a set of conversion rules to define said Web page, said rules can be used to remove and/or modify HTML element tags, therefore transforming the page “Chicago Traffic Report” (along with its business logic) into the form shown on Spyglass page 7 (shown on a PDA) (see also Spyglass pages 5-6). Spyglass does not specifically teach transformation from one markup language to another markup language. However, Carlino teaches transformation of an HTML Web page (a first format) into one of a second format (i.e. WML) suitable for display on a wireless device (i.e. PDA, etc.) (Carlino Abstract and accompanying figure) (compare with claim 1 “*accessing a first transformation rule that can be used to transform the presentation information and the business logic in a first markup language to a second markup language compatible with the first device;*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Carlino’s conversion to the conversion rules of Spyglass, providing Spyglass the benefit of different markup languages for compatibility (and greater satisfaction) for users with a wider array of wireless devices (see also Carlino Abstract, at bottom).

Spyglass teaches a set of conversion rules used for specific conversion of a Web page to a customized form (Spyglass page 5). Since the transformation with said rules utilizes the original Web page (along with its

business logic), as well as the type of target device (device attribute), said rules can be interpreted as a form of “grammar”, customized for a particular target device. Like grammar rules, Spyglass’s rule sets can be reused accordingly to render final customized output (compare with claim 1 “*generating a first grammar consistent....to generate the information.*”).

**In regard to dependent claim 2,** Spyglass teaches a cache, whereby if a user requests a document previously converted for the same device, Spyglass delivers the document directly from said cache (the first set of rules, or grammar, has already been applied and can be used for the second device of the same type) (Spyglass page 5 – top half of page).

**In regard to dependent claim 3,** Spyglass teaches a cache, whereby if a user requests a document previously converted for a different device, Spyglass applies a new set of conversion rules from the cached document (Spyglass page 5 – top half of page). Spyglass does not specifically teach transformation from one markup language to a third markup language. However, Carlino teaches transformation of an HTML Web page (a first format) into one of a second format (i.e. WML) suitable for display on a wireless device (i.e. PDA, etc.) (Carlino Abstract and accompanying figure). It is noted that Carlino page 19 bottom, to page 20 top, states that although WML is the second markup language, nevertheless, other wireless markup languages can be used (i.e. as a third language). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Carlino’s conversion (to a third language) to the conversion rules of Spyglass, providing Spyglass the benefit of different markup languages (including a new set of rules, etc.) for compatibility (and greater satisfaction) for users with a wider array of wireless devices (see also Carlino Abstract, at bottom).

**In regard to dependent claim 4,** Spyglass teaches a wireless communication medium (Spyglass Middle Figure).

**In regard to dependent claim 5**, Spyglass's "business logic" related Web page (Spyglass page 7) is originally coded in HTML, which typically can include programmed Java, JavaScript, etc., therefore said page includes programming code in a programming language.

**In regard to dependent claim 6**, Spyglass teaches a user registering himself with preferences stored in Spyglass's User Database (Spyglass page 2 item 2, also page 4 section Transaction Manager – especially second paragraph).

**In regard to dependent claim 7**, Spyglass teaches upon request of a URL, a non-PC device identifies itself to the Spyglass server. The device identification can be interpreted as a clear "hint" that a user wants a Web page to be converted for its own device accordingly (Spyglass page 2 items 1, 2). If a user requests a document which has already been converted for the same device, the converted document from the cache is delivered accordingly (in this case the "hint" is not required, because the first rule set (grammar) has already been generated and applied to the document now residing in the cache) (Spyglass page 5 – top half).

**In regard to dependent claim 8**, Spyglass does not specifically teach that the first markup language is XML. However, Carlino teaches that XML can be used as the originating (first) markup language (Carlino page 19 second paragraph from bottom). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Carlino's XML to the conversion rules of Spyglass, providing Spyglass the benefit of different markup languages (including a new set of rules, etc.) for compatibility (and greater satisfaction) for users with a wider array of wireless devices (see also Carlino Abstract, at bottom).

**In regard to independent claim 9**, claim 9 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Spyglass teaches conversions using a server, which typically incorporate software and hardware, said hardware inherently incorporating various forms of “memory” in order to function (i.e. hard drive, as well as RAM and cache memory for storing instruction data, etc.).

**In regard to dependent claims 10, 11, 12, 13, 14, 15,** claims 10, 11, 12, 13, 14, 15 incorporate substantially similar subject matter as claimed in claims 3, 4, 5, 6, 7, 8, respectively, and are rejected along the same rationale.

**In regard to independent claim 16,** claim 16 reflects the system comprising computer executable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

**In regard to dependent claim 17,** Spyglass teaches an administrative interface which can configure cache settings by specifying “conversions to be performed” for each type of device (Spyglass page 6 bottom half). Since the conversions incorporate a set of rules (a grammar) for each conversion, caching said conversions can be interpreted as (at least implicitly) storing its rules as well.

**In regard to dependent claims 18, 19, 20, 21, 22,** claims 18, 19, 20, 21, 22 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 6, 4, 5, 7, 8, respectively, and are rejected along the same rationale.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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